UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,193	05/23/2000	Kia Silverbrook	NPB001US	9142

24011 7590 01/14/2004

SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER	
YOUNG, JOHN L	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/575,193	Silverbrook et al.
Examiner	**Art Unit**
John Young	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Nov 4, 2003* .

2a) ☒ This action is **FINAL.** 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-60* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-60* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

1-12-04

FINAL REJECTION

DRAWINGS

1. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTIONS — 35 U.S.C. §103(a)

2. **Rejections Maintained.**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-60 are rejected under 35 U.S.C. §103(a) as being unpatentable over Roberts 5,772,510; class 463/17 (06/30/1998).

As per claim 1, Roberts (FIG. 1; FIG. 4; FIG. 2A; FIG. 2B; FIG. 2C; FIG. 3; FIG. 6A; FIG. 7; FIG. 8A; FIG. 8B; the ABSTRACT; col. 1, ll. 65-67; col. 2, ll. 13-67; col. 4, ll. 1-5; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; and col. 6, ll. 1.65) shows: "A system for providing to a user printed information obtained from a remote source, the system including: a user module that is provided by a first party to the user for interfacing the user with the source, the module being responsive to the user requesting first

information from the source for generating a first printed medium that displays to the user the first information together with second information derived from a second party; identifier means for applying an identifier to the first printed medium such that designation of the identifier by the user results in the module generating a second printed medium that displays to the user third information; and calculation means being responsive to the module for determining a payment to be made by the second party to the first party."

Roberts lacks explicit recitation of "identifier means for applying an identifier to the first printed medium such that designation of the identifier by the user results in the module generating a second printed medium that displays to the user third information. . . ." even though Roberts (FIG. 1; FIG. 4; FIG. 2A; FIG. 2B; FIG. 2C; FIG. 3; FIG. 6A; FIG. 7; FIG. 8A; FIG. 8B; the ABSTRACT; col. 1, ll. 65-67; col. 2, ll. 13-67; col. 4, ll. 1-5; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1.65; and whole document) reasonably suggests same. It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Roberts (FIG. 1; FIG. 4; FIG. 2A; FIG. 2B; FIG. 2C; FIG. 3; FIG. 6A; FIG. 7; FIG. 8A; FIG. 8B; the ABSTRACT; col. 1, ll. 65-67; col. 2, ll. 13-67; col. 4, ll. 1-5; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1.65; and whole document) would have been selected in accordance with "identifier means for applying an identifier to the first printed medium such that designation of the identifier by the user results in the module generating a second printed medium that displays to the user third information. . . ." because such selection would have provided *"an improved lottery ticket terminal for providing*

completed lottery tickets." (See Roberts (col. 1, ll. 65-67)).

As per dependent claims 2-25, Roberts shows the system of claim 1 and subsequent base claims depending from claim 1.

Roberts (FIG. 1; FIG. 4; FIG. 2A; FIG. 2B; FIG. 2C; FIG. 3; FIG. 6A; FIG. 7; FIG. 8A; FIG. 8B; the ABSTRACT; col. 1, ll. 65-67; col. 2, ll. 13-67; col. 4, ll. 1-5; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1.65; and whole document) reasonably suggests all of the elements and limitations of dependent claims 2-25.

Roberts lacks explicit recitation of some of the elements and limitations of dependent claims 2-25.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of dependent claims 2-25 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of dependent claims 2-25, because such elements and limitations would have provided *"an improved lottery ticket terminal for providing completed lottery tickets."* (See Roberts (col. 1, ll. 65-67)).

Independent claim 26 is rejected for substantially the same reasons as independent claim 1.

As per dependent claims 27-30, Roberts shows the system of claim 26 and subsequent base claims depending from claim 26.

Roberts (FIG. 1; FIG. 4; FIG. 2A; FIG. 2B; FIG. 2C; FIG. 3; FIG. 6A; FIG. 7; FIG. 8A; FIG. 8B; the ABSTRACT; col. 1, ll. 65-67; col. 2, ll. 13-67; col. 4, ll. 1-5; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1.65; and whole document) reasonably suggests all of the elements and limitations of dependent claims 27-30.

Roberts lacks explicit recitation of some of the elements and limitations of dependent claims 27-30.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of dependent claims 27-30 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of dependent claims 27-30, because such elements and limitations would have provided *"an improved lottery ticket terminal for providing completed lottery tickets."* (See Roberts (col. 1, ll. 65-67)).

Independent claim 31 is rejected for the same reasons as independent claim 1.

As per dependent claims 32-55, Roberts shows the system of claim 31 and subsequent base claims depending from claim 31.

Roberts (FIG. 1; FIG. 4; FIG. 2A; FIG. 2B; FIG. 2C; FIG. 3; FIG. 6A; FIG. 7;

FIG. 8A; FIG. 8B; the ABSTRACT; col. 1, ll. 65-67; col. 2, ll. 13-67; col. 4, ll. 1-5; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1.65; and whole document) reasonably suggests all of the elements and limitations of dependent claims 32-55.

Roberts lacks explicit recitation of some of the elements and limitations of dependent claims 32-55.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of dependent claims 32-55 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of dependent claims 32-55, because such elements and limitations would have provided *"an improved lottery ticket terminal for providing completed lottery tickets."* (See Roberts (col. 1, ll. 65-67)).

Independent claim 56 is rejected for the same reasons as independent claim 26.

As per dependent claims 57-60, Roberts shows the system of claim 56 and subsequent base claims depending from claim 56.

Roberts (FIG. 1; FIG. 4; FIG. 2A; FIG. 2B; FIG. 2C; FIG. 3; FIG. 6A; FIG. 7; FIG. 8A; FIG. 8B; the ABSTRACT; col. 1, ll. 65-67; col. 2, ll. 13-67; col. 4, ll. 1-5; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1.65; and whole document) reasonably suggests all of the elements and limitations of dependent claims 57-60.

Roberts lacks explicit recitation of some of the elements and limitations of dependent claims 57-60.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of dependent claims 57-60 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of dependent claims 57-60, because such elements and limitations would have provided *"an improved lottery ticket terminal for providing completed lottery tickets."* (See Roberts (col. 1, ll. 65-67)).

RESPONSE TO ARGUMENTS

4. Applicant's arguments (Amendment A, paper#6) Applicant's arguments have been fully considered and are not persuasive for the following reasons:

In response to Applicant's arguments (Amendment A, paper#6, p. 4) which asserts that "Roberts does not disclose a module that is responsive to a user requesting first information. Rather, it would appear that the 'first information' of Roberts is pre-printed on the lottery ticket and the 'module' of Roberts prints 'second' information on that lottery ticket to generate a completed lottery ticket. . . ." and further asserts that "there is no suggestion in Roberts that the provision of a second print medium containing third information is desirable. . . .", notwithstanding whether or not the *"first and second numbers"* of Roberts (see ABSTRACT) are pre-printed on the lottery ticket, based on

the undue breadth of the claims of the instant invention, Roberts (see ABSTRACT; FIG. 4; and FIG. 6A) as well as Roberts (FIG. 1; FIG. 2A; FIG. 2B; FIG. 2C; FIG. 3; FIG. 7; FIG. 8A; FIG. 8B; col. 1, ll. 65-67; col. 2, ll. 13-67; col. 4, ll. 1-5; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; and col. 6, ll. 1.65) shows "A system for providing to a user printed information obtained from a remote source, the system including: a user module that is provided by a first party to the user for interfacing the user with the source, the module being responsive to the user requesting first information from the source for generating a first printed medium that displays to the user the first information together with second information derived from a second party; identifier means for applying an identifier to the first printed medium such that designation of the identifier by the user results in the module generating a second printed medium that displays to the user third information; and calculation means being responsive to the module for determining a payment to be made by the second party to the first party." And it would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Roberts (FIG. 1; FIG. 4; FIG. 2A; FIG. 2B; FIG. 2C; FIG. 3; FIG. 6A; FIG. 7; FIG. 8A; FIG. 8B; the ABSTRACT; col. 1, ll. 65-67; col. 2, ll. 13-67; col. 4, ll. 1-5; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1.65; and whole document) would have been selected in accordance with "identifier means for applying an identifier to the first printed medium such that designation of the identifier by the user results in the module generating a second printed medium that displays to the user third information. . . ." because such selection would have provided *"an improved lottery ticket*

terminal for providing completed lottery tickets." (See Roberts (col. 1, ll. 65-67)). The claims of the instant invention do not clarify the first and second information.

It is well settled in the law that "[although] a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415, F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claims that are not recited in the claims." (See MPEP 2173.05(q)). Therefore, the claims of the instant invention read on the disclosure of Roberts; furthermore, in response to Applicant's argument that the references fail to show certain features of Applicant's invention, it is noted that the features upon which Applicant relies (i.e., that "the provision of a second print medium containing third information is desirable. . . .") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Finally, in response to Applicant's arguments (Amendment A, paper#6, p. 4-5) which asserts that dependent claims 2-25, 27-30, 32-55, & 57-60 rejected based on Official Notice evidence have been traversed, Applicant's arguments fail to present an appropriate challenge to the taking of Official/Judicial Notice because Applicant's arguments do not contain adequate information or argument to create on its face a

reasonable doubt regarding the circumstances justifying the [Official/Judicial] notice." (MPEP 2144.03 (August 2001) p. 2100-129). Applicant has failed to demand references in support of Official Notice evidence presented in the prior Office action.

Therefore, the "Official Notice" or common knowledge or well-known in the art statement is taken to be admitted prior art because Applicant's traversal is inadequate, and no further references in support of the official notice are required.

It is well settled that according to MPEP 2144.03 "If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, applicant is charged with rebutting the well known statement in the next reply after the Office action in which the well known statement was made." Therefore, "the well known statements are taken to be admitted prior art. . . ." Id.

For the reasons stated above, claims 1-60 of the instant application stand rejected.

ACTION MADE FINAL

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire

THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

CONCLUSION

5. Any response to this action should be mailed to:

Box AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

(703) 305-7687 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh Floor Receptionist
Crystal Park V
2451 Crystal Drive

Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

John L. Young
Primary Patent Examiner

January 12, 2004